

REMARKS

Summary of Office Action

Claims 1-51 are pending in the application.

Claims 8-10, 16, 21, 22, 30-40, and 49-51 were withdrawn.

The Examiner made remarks to the June 15, 2005 election/restriction that stated claims 8-10, 16, 21, 22, 30-40, 49, 50, and 51 were withdrawn, there being no allowable generic or linking claim.

Claims 1-3, 11, 15, 17, 19, and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lithwick U.S. Patent No. 4,951,404 (hereinafter "Lithwick").

Claims 24, 25, and 41-44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jacobson et al. U.S. Patent No. 3,191,340 (hereinafter "Jacobson").

Claims 14 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick.

Claims 4-7 and 12-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick in view of Hirsch U.S. Patent No. 6,484,425 (hereinafter "Hirsch").

Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick in view of Fine U.S. Patent No. 6,438,878 (hereinafter "Fine") or Gregory-Gillman U.S. Patent No. 6,151,823 (hereinafter "Gregory-Gillman").

Claims 5 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lithwick in view of Borden U.S. Patent No. 5,197,213 (herinafter "Borden").

Claims 26-29 and 45-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Hirsch.

Claim 46 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jacobsen in view of Borden U.S. Patent No. 5,197,213 (hereinafter "Borden").

Summary of Applicants' Amendments

Applicants have amended claims 1, 3, 11, 17, 24, and 41 in order to expedite prosecution.

Applicants have cancelled claims 30-40 solely to expedite prosecution.

Applicants have added new claims 51-65 in order to more particularly point out and distinctly claim the subject matter that applicants regard as the invention.

Applicant's Response to the Election Requirement

The Examiner stated that "claims which are generic to other species are construed in the context of the entire specification" (Office Action, page 2).

All claims regardless of election, however, are construed in the context of the entire specification. Elected claims may be examined with respect to the elected species and the specification. Applicant's election was made solely to expedite prosecution by allowing the Examiner to conduct a reasonable search and examination - not limit the construction of any claim.

The Examiner is reminded that claim 1 is generic (See Reply dated March 8, 2005). Particularly, withdrawn claims 8-10, 16, 21, and 22 as well as pending claims 11-15, 17-20, 23 are dependent from claim 1. Claim 1 reads on, for example, at least figures 1-3 and 6-8. It should be noted that original/pending claim 11 includes the second containment structure as a third sheet segment.

Similarly, claims 24, 41, and 53 are generic to multiple figures of applicants' specification. For example, claim 24 reads on, for example, at least figures 1-3 and 6-8. Claim 41, for example, reads on at least figures 1, 2, and 6-8. Claim 53, for example, reads on at least figures 1, 2, and 6-8.¹

Applicants election after the Reply of March 8, 2005 was made solely to expedite prosecution.

Applicant's Response to the Rejections Under 35 U.S.C. 102(b)

Claims 1-3, 11, 15, 17, 19, 20, 24, and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lithwick.

Claims 1, 3, 11, 15, 17, 19, and 20

In responding to applicant's arguments for patentability of claim 1, the Examiner stated that "applicant's elected species shown in figure 2 does not contain two distinct sheets in the sense that one of the containment sheets is a portion of the 'sheet' which also includes sheet segments (21, 22) which form the greeting card." (Office Action, page 10).

The scope of applicant's claim 1 is broader than figure 2. Figure 1, for example, also reads on claim 1

¹ Applicants note that figures should be commensurate in scope with the entire specification - especially the specification directly, and indirectly, associated to the figure. Applicants note that not all elements of a claim have to be included in a single figure and that a figure can read on a claim without including all elements of that claim. Applicant's examples of particular figures that read on particular claims are just that - examples.

(e.g., claim 1 is generic to claims 3 and 11). Solely in order to expedite prosecution, applicant notes that figure 2 at least includes a first and second sheet segment folded about a first fold line (e.g., sheet 22 and 28 around fold line 27 or sheets 22 and 21 folded around line 23) and an aperture defined in said first sheet segment (e.g., aperture 24 in sheet 22).

As for the second containment structure of claim 1, original claim 11 states that the second containment structure is a third sheet segment of said folded sheet folded about a second fold line. Figure 2 includes a third sheet segment.

As shown above, the second containment structure of claim 1 is broad enough to cover multiple figures and embodiments (e.g., See claim 3) and that figure 2, for example, can be utilized to fabricate the greeting card of figure 1 (e.g., by attaching segments 20 and 22 together).

Solely to expedite prosecution, applicant has amended claim 1 to include a second containment portion separate from the first containment sheet.

The Examiner stated that Lithwick shows "a first transparent containment sheet (26) ... [and] ... a second transparent containment sheet (25)" (Office Action, page 3).

Lithwick, however, does not show or suggest two distinct containment portions. Lithwick, at best, only discusses a container formed from a single sheet - "a molded sheet of acrylic The sheet ... stamped out of a flat material and has molded therein a first tray-like cavity ... and a second tray-like cavity" (Luthwick, col. 2, lines 33-37). Furthermore, the "regions within which the

cavities ... appear are separated from each other by a fold line 27" (Luthwick, col. 2, lines 39-42).

Applicants' claim 1, however, includes a special effects container that is formed from two separate containment portions - not one. As a result, numerous functional advantages are provided. For example, the use of two containment sheets allows for numerous design and manufacturing alternatives.

In light of the foregoing, applicants respectfully request that the Examiner's rejection of claim 1, and any claims dependent therefrom, under U.S.C. § 102(b) be withdrawn.

Claim 24 and 25

Claims 24 and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jacobson.

Claim 24 has been amended solely to expedite prosecution. Amended claim 24 includes a special effects container where a portion of the special effects container is non-transparent. An example of a non-transparent portion is a non-transparent indicia.

Jacobson includes a "transparent container or pocket 45" (Jacobsen, col. 2, lines 60-61). Jacobsen must include a transparent container or pocket because Jacobsen's device is a book "for selectively displaying pictures behind a transparent container containing loose, shiftable pieces" (Jacobsen, title). Thus, making a portion of a special effects container non-transparent would eviscerate the spirit of the Jacobsen device as a portion of a picture stored behind such a non-transparent portion could never be seen by a user.

Applicants' invention of claim 24, however, includes a special effects container with a non-transparent portion (e.g., an indicia). As per just one example:

"suppose that [the] image ... is a snowman.... Now, suppose that substance 15 includes water and a non-buoyant confetti that resembles snow. In this example, if [the] greeting card ... is shaken by a user then the user will see the illusion of snow falling in front of and on the snowman."

(applicants' specification, paragraph 21)

Implementations of particular types of material have long been held as patentable features. Similarly, implementations of printed indicia have long been held as patentable features (e.g., See *In re Dembicza*k, 175 F.3d 994, 50 U.S.P.Q.2d 1614 and *Mcginley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 U.S.P.Q.2d 1001).

In light of the foregoing, applicant respectfully requests that the Examiner's rejection for claim 24, and any claims dependent therefrom, be withdrawn.

Claims 41-44

Claims 41 and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jacobson.

Applicant' have amended claim 44 solely to expedite prosecution. Claim 44 includes a special effects container formed from a second sheet segment having an aperture, a transparent sheet covering the aperture, and a first sheet segment not having an aperture. The first and second sheet segments are from a non-transparent sheet.

As shown above in connection with claim 24, Jacobson does not show or suggest anything other than a completely transparent pocket and the functionality of this pocket depends solely on the transparency of the pocket.

In light of the foregoing, applicant respectfully requests that the Examiner's rejection for claim 41, and any claims dependent therefrom, be withdrawn.

Applicant's Response to the Rejections Under 35 U.S.C. 103(a)

Claims 14 and 18

Claims 14 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lithwick. As shown above, claim 1 is in condition for allowance. Claims 14-18 depend from allowable claim 1. Accordingly, applicants respectfully submit that claims 14 and 18 are in condition for allowance.

Claims 4-7 and 12-14

Claims 4-7 and 12-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick in view of Hirsch.

As shown above, claim 1 is in condition for allowance. Claims 4-7 and 12-14 depend from claim 1. Accordingly, applicants respectfully submit that claims 4-7 and 12-14 are in condition for allowance.

Claim 23

Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick in view of Fine or Gregory-Gillman.

As shown above, claim 1 is in condition for allowance. Claim 23 depends from allowable claim 1. Accordingly, applicants respectfully submit that claim 23 is in condition for allowance.

Claims 5 and 28

Claims 5 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lithwick in view of Borden.

As shown above, claims 1 and 24 are in condition for allowance. Claim 5 depends from claim 1 and claim 28 depends from allowable claim 24. Accordingly, applicants respectfully submits that claims 5 and 28 are in condition for allowance.

Claims 26-29 and 45-48

Claims 26-29 and 45-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Hirsch.

As shown above, claims 26-29 and 45-48 are in condition for allowance. Claims 26-29 depends from claim 1 and 45-48 depends from allowable claim 41. Accordingly, applicants respectfully submits that claims 26-29 and 45-48 are in condition for allowance.

Claim 46

Claim 46 was rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen in view of Borden.

As shown above, claim 41 is in condition for allowance. Claim 46 depends from allowable claim 41. Accordingly, applicants respectfully submit that claim 46 is in condition for allowance.

Withdrawn Claims

Applicants remind the Examiner that many withdrawn claims depend from independent claims. Upon

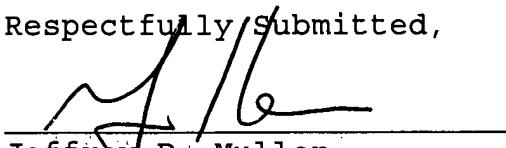
allowance of any independent claim; the withdrawn claims that depend from the allowed independent claim must be reinstated.

Conclusion

Applicants respectfully submit that this application, including claims 1-65, is in condition for allowance.

Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully Submitted,



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